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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/574,453	05/19/2000	Hiroshi Tanaka	FJ-2000-004-US	8724
21254	7590	05/19/2005	EXAMINER	
MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/574,453

Applicant(s)

TANAKA ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 14, 16-17 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13, 15 and 18-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 12/31/04.
- Claims 1-31 are pending in application.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-13, 15, 18-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al (U.S. 6573927), and in view of Ito et al (U.S. 6453071).

Regarding claim 1, Parulski discloses a print designation method, comprising:

(1) storing (memory card, col. 2, lines 10-13), in a print designation file (print order file "utilization file", col. 2, lines 1-27) in a recording medium in which a file including image data is stored (print order file includes images to be printed, col. 2, lines 1-27 and col. 3, lines 25-67), print designation information to be designate an image to be printed which is stored in the recording medium, wherein the print designation information includes:

(a) file specifying information (print order includes images to be printed, appendix I, cols. 6-9) for specifying a subject file including the image to be printed; and  
(b) file type specifying information (print order includes image type, appendix I, cols. 6-9) for identifying whether the subject file comprises a moving image file or a still image file ("file type" such as JPEG, cols. 7-9).

However, Parulski does not explicitly disclose wherein if the subject file comprises is the moving image file, the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file.

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Ito, in the same field of endeavor for printing, teaches the print designating information further includes scene specifying information for specifying a subject scene to be printed in the moving image file (selecting and extracting a specific scene from a moving file to be printed, figs. 23-29, col. 20, lines 35-42 and col. 25, lines 50-67 to col. 26, lines 1-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Parulski as per teachings of Ito because of a following reason: (1) to allow operators/users to select a desired framed/still image from a moving file to be printed.

Therefore, it would have been obvious to combine Parulski with Ito to obtain the invention as specified in claim 1.

Regarding claim 2, Parulski further discloses the print designation method as defined in claim 1, wherein the file specifying information includes at least one of a path indicating a storage location ("ImageLocation" of utilization file, col. 7) of the subject file and a file number of the subject file.

Regarding claim 3, Parulski further discloses the print designation method as defined in claim 1, wherein the type identifying information includes a format type (filetype, cols. 7-8) of the subject file.

Regarding claim 4, Ito further discloses the print designating method as defined in claim 1, wherein the file type identifying information includes information directly indicating whether the subject file comprises is the moving image file or the still image file (figs. 23-29).

Regarding claim 5, Parulski further discloses the print designating method as defined in claim 1, wherein the file type identifying information includes an extension of a file name of the subject file (".fpx", col. 7).

Regarding claim 6, Parulski further discloses the print designating method as defined in claim 1, wherein the file type identifying information includes file type information indicating a

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file type of the subject file, the file type information comprising initial letters of a file of the subject file (image4.fpx, col. 7).

Regarding claim 7, Ito further discloses the print designating method as defined in claim 1, wherein the scene specifying information includes a frame number specifying where a frame corresponding to the image data of the subject scene is in the moving image file (figs. 23-29).

Regarding claim 8, Ito further discloses the print designation information method as defined in claim 1, wherein the scene specifying information includes start position information of the image data of the subject scene in the moving image file (figs. 23-29).

Regarding claims 9-10, Ito further discloses the print designating method as defined in claim 8, wherein the start position information includes an offset address from one of a top of the moving image file and a bottom of a header of the moving image file (fig. 16-17 and figs. 23-29).

Regarding claims 12 & 15 recite limitations that are similar and in the same scope of invention as to those in claim 1 above; therefore, claims 12 & 15 are rejected for the same rejection rationale/basis as described in claim 1.

Regarding claim 13, Ito further teaches the print designating device as defined in claim 12, wherein: the print designating device comprises an electronic camera (digital camera 12, fig. 1a) comprising an imaging device and a recording which encodes and stores image data obtained through the imaging device in the recording medium; and electronic camera stores the file including the image data and the print designating file in the recording medium.

Regarding newly added claims 18-31 recite limitations that are similar and in the same scope of invention as to those in claims 1-10 above; therefore, claims 18-31 are rejected for the same rejection rationale/basis as described in claims 1-10.

### *Response to Arguments*

Applicant's arguments filed 12/31/04 have been fully considered but they are not persuasive.

- Regarding claims 1-31, the applicants repeatedly argued that the Examiner's stated motivation is deficient in establishing a reasonable motivation.

- In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Parulski explicitly teaches a motivation for creating a print designation file (i.e. print order utilization file as shown in Appendix I), for example, the proper number of each selected image is then automatically printed without further user intervention (col. 6, lines 19-26) and to provide the utilization information for multiple images in a single utilization file without having to duplicate each image for each print order ((col. 6, lines 27-30) which is equivalent to Applicant's motivation). According to the originally filed specification, a print designation file and designated image to be printed are stored in a same memory device (i.e. memory card) and such print designation file contains instruction for printing designated image stored in a memory device (i.e. memory card). Parulski teaches the same features (i.e. print designation file for still images) except for moving image data. Ito teaches a digital camera for recording still and moving image data, which is also known in the art and also admitted by the applicant. Ito teaches a method for printing (i.e. print instruction S2003 as shown in fig. 20) a selected scene from a moving image data. Ito's motivation of doing so is taught on col. 24, lines 53-58 "the communication system of the first embodiment can not only select still image information *contained in moving image information without using an editing apparatus such as PC*, but also print the still image information with ease and quickly.

- Regarding claims 1-31, the applicants repeatedly argued the cited prior arts of record (US 6573927 and US 6453071) fail to teach and/or suggest "avoiding wasting of the memory

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capacity of the recording medium” and “without redundantly storing (i.e. duplicating) on the recording medium”.

In response, the examiner cannot locate such limitations as indicated above in any pending independent claims and the applicants fail to point out where such limitations are taught in the originally filed specification. According to the originally filed specification as shown in fig. 8, step S342 and S344 show before printing any selected scene from a moving image file, such scene is extracted and stored in memory device; therefore, it duplicates a scene and stored in memory device before for printing, which contradicts the applicants' arguments.

NOTES: Also referring to the originally filed specification (page 20, lines 11-15), the applicants admitted “motion JPEG as example, which lists the images of respective screens of independent JPEG images”. Parulski teaches a camera for capturing series of independent JPEG images, which can be interpreted as a “Motion” JPEG images. As shown in col. 8, Appendix I, a print order utilization file is generated for scene “image4.fpx”. Obviously, “image4.fpx” is a scene from Motion JPEG, which lists the images of respective screens of independent JPEG images, for example, image00.fpx to image100.fpx. A camera for recording both still and moving images is taught by Ito and also admitted by the applicants.

#### ***Allowable Subject Matter***

- Claims 11, 14, and 16-17 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: “determining whether the subject file comprises the still image file or the moving image file in accordance with the type identifying information, wherein if the subject file is determined as the still image file, the printing method further comprises printing the image data is the subject file, ***and wherein if the subject file is determined as the moving image file, the printing method further comprises: reading the scene specifying information; taking the image data out of the subject scene in the moving image file in accordance with the scene specifying information***”.

Claims 11, 14, and 16-17 contain allowable subject matters, which shows to be distinguished over the cited prior arts of record.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

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GABRIEL GARCIA  
PRIMARY EXAMINER